

REMARKS

The application has been amended to place the application in condition for allowance at the time of the next Official Action.

The specification is amended to include reference numeral 54 on page 8, line 28, denoting the axial chamber as seen in Figures 1 and 2 of the present invention. The above change is believed sufficient to address the drawing objection noted in the Official Action and is believed not to introduce new matter.

The specification is further amended to include section headings.

The specification is still further amended to remove claim numbers from the specification and to incorporate the suggested changes noted on page 4 of the Official Action. Accordingly, reconsideration and withdrawal of the disclosure objection is respectfully requested.

Claims 1-18 were previously pending in the application. Claims 6, 7 and 15 are canceled and new claim 19 is added. Therefore, claims 1-5, 8-14 and 16-19 are presented for consideration.

Claims 1, 3, 4, 9, 12 and 15 are amended to incorporate the suggestions kindly noted in the Official Action to address the claim objections noted in the Official Action.

As to claims 2-11 and 13-18, applicants note that although the specification must be in the English language, it is

not required to be in American English. Nevertheless, applicants have removed the term "characterized in that" and replaced this with "wherein". Accordingly, withdrawal of the claim objections is respectfully requested.

Claims 9 and 10 are amended to clarify the recited locking means and flexible rear tongues. Claim 10 is further amended to provide proper antecedent basis for the recited circular operating crown. As noted in the Official Action, the term "contrast element" in claim 18 should be "abutment member" and claim 18 has been amended accordingly. In view of the above, it is believed that the 35 USC 112, second paragraph rejection is believed addressed and reconsideration and withdrawal of the same are respectfully requested.

Claims 1-6 and 9-14 were rejected under 35 USC 102(b) as being anticipated by PETRUSSA 5,376,080. That rejection is respectfully traversed.

Claim 1 is amended to include the subject matter of claim 7. Since PETRUSSA was not applied against claim 7 as part of an anticipation rejection, claim 1 as thus amended is believed to overcome the rejection over PETRUSSA. Similarly, independent claim 12 is amended to include the subject matter of claim 15. As PETRUSSA was not applied against claim 15 as part of the anticipation rejection, the anticipation rejection is believed obviated and withdrawal of the same is respectfully requested.

The dependent claims are believed to define over PETRUSSA at least for depending from an allowable independent claim.

Claims 7, 8, 15 and 16 were rejected under 35 USC 103(a) as being unpatentable over PETRUSSA in view of DOMICI, Jr. Publication No. 2001/0037089 and CHOKSI 4,737,144. That rejection is respectfully traversed.

The Official Action recognizes that PETRUSSA fails to disclose a pair of front tongues and a pair of back tongues for securing the sleeve in a forward position. DOMICI, Jr. is offered for this feature with the Official Action further noting that DOMICI, Jr. does not disclose the tongues formed on a sleeve but instead forms the tongues on the syringe body itself. The position set forth in the Official Action is that CHOKSI discloses a locking device on the sleeve itself and thus it would have been obvious to have the locking device of DOMICI, Jr. on the sleeve and further obvious to include such a device in PETRUSSA for performing the same task of locking the syringe while shielding the needle of the syringe.

However, this position is believed to be untenable for at least the following reasons.

First, the Second Circuit has held that "one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988).

The Examiner picked from DOMICI, Jr. the tongues on the syringe and stated that these could be moved to the sleeve. However, the Examiner ignored that the tongues (tabs 16, 20) of DOMICI, Jr. mate with a respective slot 54 in order to provide a locking function. Such slot is necessary for the locking function. The Examiner cannot ignore slot 54 because it is necessary for the full appreciation of what DOMICI, Jr. fairly teaches and suggests to one of ordinary skill in the art (i.e., locking by having tabs 16, 20 engage in slot 54).

Therefore, the Examiner used impermissible hindsight reconstruction by picking the tabs of DOMICI, Jr. and excluding the associated slot necessary for full appreciation of locking.

Moreover, the Examiner's articulated reasoning in the rejection does not possess a rational underpinning to support the legal conclusion of obviousness in that the slot cannot be separated out from the tabs from the teaching of a locking mechanism as a whole, which necessarily includes the slot.

Thus, the picking of the tabs to the exclusion of the slot and the articulated reasoning of teaching elements for performing the same task to combine the references does not support the legal conclusion of obviousness.

Furthermore, as noted in the Official Action, CHOKSI discloses a single locking means 20 on the sleeve itself. CHOKSI fails to disclose a pair of forward and rear tongues. Rather, CHOKSI at least in the embodiment of Figure 6, shows a bayonet

lock in order to improve the locking system. CHOKSI uses such bayonet system and the necessary rotation of the sleeve to prevent movement of the sleeve by the user. Such a locking configuration is not an obvious variant of that of DOMICI, Jr.

In any event, the protective sleeve 20 of PETRUSSA has a plurality of longitudinal slots 19 that enable tongues 17 of guide element 35 to slide therein. Thus, as seen in Figure 3 of PETRUSSA, there would be nothing for forward and rear tongues to engage in order to perform a locking function. Thus, the suggested combination would result in an inoperative device.

Second, incorporating tongues in PETRUSSA would change the principle of operation of PETRUSSA.

PETRUSSA uses a diaphragm 13 to prevent the needle from exiting the body. Such diaphragm snaps into the front end of the container, when the container 19 is in the safety position of PETRUSSA. Thus, PETRUSSA teaches an alternative manner for providing a safety function. In view of this, modifying PETRUSSA to include an additional or different safety function would change the principle of operation of PETRUSSA (safety by the use of a diaphragm). As such, the proposed modification would not have been obvious.

In view of the above, it is apparent that not only is it improper to combine the references in the manner suggested, but the proposed combination would not result in an operative device that meets the present claims.

Independent claim 12 is amended to include the subject matter of claim 15 and includes similar features and the analysis above is equally applicable to claim 12.

Claim 17 was rejected under 35 USC 103(a) as being unpatentable over PETRUSSA in view of SHAW 7,118,552. That rejection is respectfully traversed.

Claim 17 depends from claim 12 and further defines the invention. SHAW does not overcome the shortcomings of PETRUSSA as set forth above with respect to claim 12. Accordingly, claim 17 is believed patentable at least for depending from an allowable independent claim.

Claim 18 was rejected under 35 USC 103(a) as being unpatentable over PETRUSSA in view of RESTELLI et al. 6,419,658. That rejection is respectfully traversed.

RESTELLI is only cited with respect to features of dependent claim 18. RESTELLI does not overcome the shortcomings of PETRUSSA set forth above with respect to claim 12. Since claim 18 depends from claim 12 and further defines the invention, claim 18 is believed patentable at least for depending from an allowable independent claim.

New claim 19 is added and also includes the feature of the pair of front and rear tongues that lock the sleeve when the sleeve is in a forward position of safety. The analysis above regarding claim 1 is equally applicable to claim 19.

In view of the present amendment and the foregoing Remarks, it is believed that the present application has been placed in condition for allowance. Reconsideration and allowance are respectfully requested.

The Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 25-0120 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17.

Respectfully submitted,

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